

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/994,560
Confirmation No.: 8731
First-Named Inventor: Harold L. Bennett
Filing Date: November 27, 2001
Group Art Unit: 1714
Examiner: Cephia D. Toomer
Attorney Docket No.: 031088-000002
Title: PROCESS FOR PRODUCTION OF LOW-TEMPERATURE CHAR
DURING PRODUCTION OF LOW-TEMPERATURE TARs

RENEWED PETITION UNDER 37 C.F.R. § 1.137(B)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Decision mailed April 8, 2009, Applicant hereby renews the petition to revive the application, pursuant to 37 C.F.R. § 1.182, and, in the alternative, pursuant to 37 C.F.R §§ 1.137 and 1.181. In support of the renewed petition, please consider the following remarks and evidence.

Petition Under 37 C.F.R. § 1.182

According to the Decision on Petition, mailed May 8, 2009, the petition pursuant to 37 C.F.R. § 1.182 was dismissed on the grounds that this section of the Regulations provides for questions not specifically provided for elsewhere in the regulations. According to the Decision, the relief sought is provided for under 37 C.F.R. § 1.181, and “the question of whether the application should be revived is provided for in the regulations at 37 C.F.R. § 1.137.”

Applicant respectfully submits that it is seeking relief that is not described under the provisions of § 1.137 (though Applicant also seeks relief, in the alternative, under those provisions.) Section 1.137 only provides for the revival of an application that becomes abandoned *due to an applicant's failure to timely reply* to an office action. As the record in this file plainly shows, the amendment was timely filed, and, therefore, the application did not become abandoned due to the applicant's failure to file a timely response.

As discussed in the petition, Applicant (by counsel) filed a timely response to the office action. This response canceled claims to the subject matter that the Examiner had rejected, and amended the claims to correct the technical objections made by the Examiner to the claims the Examiner had indicated were patentable. In other words, the response sought to implement all of the changes that the Examiner had indicated would place the application in a condition for allowance, and only those changes.

This response was misplaced by Patent Office. When Examiner Toomer contacted Applicant's counsel, asking whether a response had been filed, counsel informed her that one had. Counsel for Applicant also informed Examiner Toomer that, should she be unable to locate the response, Applicant would be happy to provide a replacement copy. The Examiner never requested such a replacement, leading Applicant's counsel to conclude that the response had been located.

Applicant therefore respectfully notes that it seeks revival of the application on grounds not specifically provided for under the standards set forth in 37 C.F.R. § 1.137, nor anywhere else in the rules: Applicant seeks entry of an amendment that placed the application in a condition for allowance, and which was timely filed but which, due to an error in the Patent Office, the Patent Office failed to enter. Applicant also seeks such further action as is

appropriate in view of the entry of the amendment, including an opportunity to pay the associated issue fees or correct any minor informality that the Examiner may find in the response.

Petition Under 37 C.F.R. § 1.181 and § 1.137

In the alternative, Applicant respectfully seeks further consideration of its petition to revive pursuant to 37 C.F.R. § 1.137, and, in view of the positions set forth in the Decision, pursuant to 37 C.F.R. § 1.181.

According to the Decision, the fact that a response was timely filed “supports a conclusion that the delay was unintentional,” but that there is a “real question as to whether there was ever a deliberate decision not to continue prosecution.” The Decision therefore concludes that “it is appropriate to request additional explanation as to why the delay in filing a response of the Office action and in filing a petition should be considered unintentional (or unavoidable).”

As to the request for an explanation as to the delay in filing a response to the Office action, again, there simply was no such delay—the response was timely filed. In view of the comments of Examiner Toomer, it appears that the Patent Office misplaced the response, and, despite saying that, if unable to locate it, she would ask for another copy, she failed to do so.

As to the request for an explanation as to the delay in filing a petition to revive, in response to this request, Applicant has reviewed his records and located a business plan dated August, 2005 (attached hereto as Exhibit A). This business plan includes a capitalization plan that was prepared in April, 2003. It also includes an explicit reference to the instant patent application, including a copy of the text of the Abstract (located on the last page). It is respectfully submitted that this document shows that, as of both April, 2003 and August, 2005,

Applicant still believed the application to be pending, and that the applicant's failure to seek revival of the application was the consequence of the fact that he believed the application was still pending, awaiting further action by the Patent Office. The application is listed as having been abandoned effective April 16, 2003.

In further support, counsel for Applicant's counsel notes that, from our records, it does not appear that a Notice of Abandonment was ever received. Had one been received, there would have been a corresponding docket entry, given the state of the file at that time, to file a petition to revive. Our records reflect no such docket entry. It is also our procedure to mount any such notice of abandonment in the file, and no such notice is in our file.

Further Comments:

Applicant notes that revival of the application is consistent with the public interest. Disclosure of the invention to the public has not been delayed, since the application was published on May 29, 2003. Furthermore, Applicant could not gain, and the delay in prosecution was not an attempt to gain, any unfair patent term extension. The term of any patent that might issue would be 20 years from the date of filing. Any term adjustment that might otherwise be provided pursuant to 35 U.S.C. § 1.54(b) based upon events prior to this petition is likely limited by 35 U.S.C. § 1.54(b)(2)(C)(i), but, in any event, should the application be revived and an extension of time be added to the term for such pre-petition delays, Applicant will terminally disclaim such term.

Conclusion

It is respectfully submitted that, by the amendment that was timely filed on May 15, 2003, the application was placed in a condition for allowance. Applicant requests that the amendment be entered, and that further appropriate action in view of that amendment be taken.

Respectfully submitted,

By /Quentin G. Cantrell/

Quentin G. Cantrell, Reg. No. 47469
Woodard, Emhardt, Moriarty, McNett & Henry LLP
111 Monument Circle, Suite 3700
Indianapolis, Indiana 46204-5137
Telephone: (317) 634-3456
Fax: (317) 737-7561
Email: qcantrell@uspatent.com